

AMENDMENT AND RESPONSE TO OFFICE ACTION

Remarks

The undersigned would like to thank Examiner Fubara for her time during the in person interview on October 15, 2009. During the interview, the undersigned explained how the polymers in the claimed compositions are different from the polymers described in U.S. Patent No. 5,756,652 to Storey *et al.* ("Storey"). The Examiner agreed that the polymers in the claimed compositions are not disclosed, explicitly or inherently, in Storey or U.S. Patent No. 6,303,138 to Peterson *et al.* ("Peterson"). The undersigned and the Examiner discussed claim language to more clearly define the polymers in the claimed compositions. Solely to facilitate allowance, the undersigned agreed to amend independent claim 1 to specify that the poly(ester anhydride) comprises random ester bonds along the polyanhydride backbone. Support for this amendment is found at least in Figure 1; page 13, lines 14-19; page 14, lines 24-26; and page 15, lines 11-13. It is the undersigned's understanding that the claims are now in condition for allowance.

Rejection Under 35 U.S.C. § 112, first paragraph

Claims 1-3, 6-10, and 15-27 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor had possession of the claimed invention. Applicants respectfully traverse this rejection to the extent that it is applied to the claims as amended.

Solely for the purpose of facilitating allowance, claim 1 has been amended to delete the rejected language and to specify that the polymers in the claimed compositions comprise random

AMENDMENT AND RESPONSE TO OFFICE ACTION

ester bonds along the polyanhydride backbone. Support for this amendment is found at least in Figure 1; page 13, lines 14-19; page 14, lines 24-26; and page 15, lines 11-13. During the interview of October 15, 2009, the Examiner agreed that the amendment was supported by the specification.

Rejection Under 35 U.S.C. § 102

Claims 1-3 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,303,138 to Petersen *et al.* ("Petersen"). Claims 1, 3, 6, 7, 17, 21, and 25 were under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,756,652 to Storey *et al.* ("Storey"). Applicants respectfully traverse this rejection.

Analysis

Petersen

As discussed above in the Remarks section, the Examiner agreed that the polymers in the claimed compositions were not explicitly or inherently disclosed in Petersen. Accordingly, claims 1-3 are novel over Petersen.

Storey

During the interview with the Examiner on October 15, 2009, the undersigned explained that the claimed compositions comprise a biodegradable, aliphatic poly(ester-anhydride) copolymer comprising random ester bonds along the polyanhydride backbone and that, in contrast, Storey discloses poly(ester anhydrides) having anhydride bond(s) along the polyester backbone. The Examiner agreed that Storey does not explicitly or inherently disclose the

AMENDMENT AND RESPONSE TO OFFICE ACTION

polymers in the claimed compositions. Accordingly, claims 1, 3, 6, 7, 17, 21, and 25 are novel over Storey.

Rejection Under 35 U.S.C. § 103

Claims 1, 3, 6-8, 15-19, 21, 22, and 25-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Storey, in view of U.S. Patent No. 5,859,271 to Franson *et al.* ("Franson") and U.S. Patent No. 5,480,787 to Negishi *et al.* ("Negishi"). Claims 1, 3, 9, 10, 17, 20, 23, and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Storey, in view of U.S. Patent No. 5,846,565 to Brem *et al.* ("Brem"). Applicants respectfully traverse this rejection.

Analysis

Storey is discussed above. Storey does not explicitly or inherently disclose compositions comprising a biodegradable poly(ester anhydride) aliphatic poly(ester-anhydride) copolymer comprising random ester bonds along the polyanhydride backbone.

Franson and Negishi describe the esterification carboxylic acids to form esters. During the interview on October 15, 2009, the Examiner agreed that Franson and Negishi do not cure the deficiencies of Storey. Accordingly, claims 1, 3, 6-8, 15-19, 21, 22, and 25-27 are not obvious over Storey in view of Franson and Negishi.

Brem describes encapsulating drugs, such as in microparticles, microcapsules, and microspheres. During the interview on October 15, 2009, the Examiner agreed that Brem does

AMENDMENT AND RESPONSE TO OFFICE ACTION

not cure the deficiencies of Storey. Accordingly, claims 1, 3, 9, 10, 17, 20, 23, and 24 are not obvious over Storey in view of Brem.

Allowance of claims 1-3, 6-10, and 15-27, as amended, is respectfully solicited.

Respectfully submitted,

/ Michael J. Terapane /

Michael J. Terapane, J.D., Ph.D.
Reg. No. 57,633

Date: October 23, 2009

PABST PATENT GROUP LLP
1545 Peachtree St., Ste. 320
Atlanta, Georgia 30309
(404) 879-2155 (Telephone)
(404) 879-2160 (Facsimile)